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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/267,639	03/15/1999	TAKU KATOH	04329.2078	7338

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

CALLAHAN, PAUL E

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/267,639

Applicant(s)

KATOH ET AL.

Examiner

Paul Callahan

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14,15 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14,15 and 17-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Claims 14, 15, and 17-23 are pending and have been examined.

Response to Arguments

2. Applicant's arguments filed 6-22-05 have been fully considered but they are not persuasive.

The applicant argues in traverse of the rejection of the claims as anticipated by Itami '852, by asserting that Itami fails to teach embedding identification information to a part of said main body of data to which error correction coding is performed based on position information. Yet such is indeed taught by Itami at (col. 14 lines 50-67 and col. 15 lines 1-10). The applicant argues in traverse of the rejection of the claims as anticipated by Itami by asserting that Itami fails to teach embedding position information as well. Yet such is indeed taught by Itami at (col. 14 lines 50-60).

The applicant argues in traverse of the rejections of the claims as obvious over Itami in view of Sako EPO 794 496 A1 by asserting that Sako also fails to teach embedding position information as well. However, this is countered by noting that Sako was not used to teach such a feature, Itami was used to teach this as noted supra.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 14-16, 19, and 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Itami et al., US 5418852.

As for claim 14, Itami teaches a method of embedding identification information in a main body of data of a digital record medium by using an error correction technology comprising (abstract); error correction encoding to digital data including digital contents to correct the error occurring in the transmission line with which the main body of data is obtained (co. 14 lines 50-68, fig. 26 item S120, col. 15 lines 1-50); embedding the identification information to a part of said main body of data to which an error correction encoding is performed based on position information (col. 14 lines 60-67, col. 15 lines 1-10); and storing said main body of data including said embedded identification information into said digital record medium (col. 15 lines 1-50). Itami teaches embedding the position information to a part of said main body of data to which an error correction encoding is performed (col. 14 lines 50-67).

As for claim 15, Itami teaches a method according to claim 14, wherein said identification information is embedded to a data part stored in an area where control information of contents data in a record area is recorded (col. 15 lines 1-50).

As for claim 19, Itami teaches a method according to claim 14 wherein an embedded position of said identification information is given by a table form (col. 14 lines 50-67, col. 19 lines 1-15).

As for claim 21, Itami teaches a method of extracting an identification information from a main body of data of a digital record medium in which includes embedded identification and position information by using an error correction technology comprising; reading said main body of data in which includes embedded identification information from said digital record medium (col. 14 lines 50-67, col. 15 lines 1-50); extracting said identification information from the main body by an error correction decoding based on the position information; and error correction decoding the main body of data after extracting said identification information in which original digital data is obtained (col. 15 lines 1-67).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 17, 18, 20, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itami and Sako et al. International patent Application No. EPO 794 496 A1.

As for claim 17, Itami teaches an information to acquire an embedded position of said identification information has an initial value information (col. 15 lines 50-60), an embedded position information indicating an embedded position of said identification information (col. 15 lines 50-60), and a plurality of position information to acquire a position of said embedded position information (col. 15 lines 50-60); a first position information to acquire the position of said embedded position information is recorded at a position obtained by converting said initial value information by a predetermined function or a position shown by a position obtained as a result of the conversion (col. 15 lines 50-60); and a second or later position information is recorded in another position of the position obtained by converting a storage information of a position of a result when an information stored at another position of a side where said position information is not stored is further converted by said predetermined function in any positions obtained by a conversion result of said predetermined function, or a storage information at a position indicated to a position of a result of conversion one by one (col. 15 lines 40-65). Sako teaches all of the limitations of claim 17 that Itami not teach, namely that said identification information has a plurality of partial identification information (col. 5 lines 6-37). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated this feature into the system of Itami. Motive to make

this combination is discussed for example, in the abstract of Sako where the advantage of large amounts of identification information being stored in thwarting illegal copying is discussed.

As for claim 18, Itami teaches a method wherein; an information to acquire an embedded position of said identification information has an initial value information (col. 15 lines 50-60), an embedded position information indicating embedded position of said identification information (col. 15 lines 45-60), and position information to acquire a position of said embedded position information (col. 15 lines 45-60); an initial position information is recorded at a position obtained by converting said initial value information by a predetermined function or a position shown by a position obtained as a result of conversion by said predetermined conversion formula (col. 7 lines 50-67, col. 8 lines 1-30); and a position information after that is recorded at a position based on a data recorded by a predetermined distance at a position indicated by a position information obtained immediately before or a distance obtained by a predetermined conversion formula, or a position obtained by converting a position information obtained immediately before by a predetermined conversion formula (col. 7 lines 50-67, col. 8 lines 1-30). Sako teaches all of the limitations of claim 17 that Itami not teach, namely that said identification information has a plurality of partial identification information (col. 5 lines 6-37). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated this feature into the system of Itami. Motive to make this combination is discussed for example, in the abstract of Sako

where the advantage of large amounts of identification information being stored in thwarting illegal copying is discussed.

As for claim 20, Sako teaches the limitations of the claim that Itami fails to teach, namely a method according to claim 14, wherein said presentation target data is scrambled or encoded to make said identification information a key before an error correction encoding is performed (col. 5 lines 7-37). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated this feature into the system of Itami. It would have been desirable to do so as this would allow for greater security in the storage of identification information on the disk.

As for claim 22, Sako teaches the limitations of the claim that are not held in common to those of claim 1 that are taught by Itami, namely encrypting digital data including digital contents by using said identification information (col. 5 lines 7-37). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated this feature into the system of Itami. It would have been desirable to do so as this would allow for greater security in the storage of identification information on the disk.

As for claim 23, Itami teaches the method of claim 22 where said identification information is embedded to a data part stored in an area where control information of contents data in a record area is recorded (col. 15 lines 1-50).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US patent Documents teach systems of copy control pertinent to the applicant's invention:

Lang 5,065,429

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

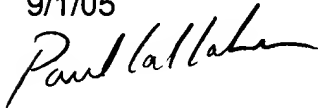
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

9/1/05



EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER